

REMARKS

Claims 32-40 are directed to non-elected inventions (Groups B and C) and have been cancelled.

Claim 14 has been amended to remove the alternative "or a battery-powered device." Providing a battery-powered device inherently is encompassed by providing a portable power source, for example, a battery, since the battery-powered device includes a battery. As a result, "battery-powered device" is redundant. Applicants have added new claim 50, which depends from claim 14 and requires that the portable power source is provided to the user with the device.

Claim 14 also has been amended to replace "battery" with "portable power source". Support for the amendment can be found in the first sentence of the Summary.

Claim Objections

Applicants have added the word "information" to claims 13, 15, and 16 to address the objection to the language "communicating battery usage". The other claims including language that the Examiner objected to have been cancelled.

35 U.S.C. § 112, ¶ 2 Rejection

Applicants have amended claims 8 and 14 to address the 35 U.S.C. § 112, ¶ 2 concerns raised by the Examiner. As a result, applicants request that the 35 U.S.C. § 112, ¶ 2 rejection be withdrawn.

Prior Art Rejections

Claims 1, 4, 5, 7, 8, 11, 13-15, 17-19, 21-33, 25, 26, and 41-43 have been rejected under 35 U.S.C. § 102(b) as anticipated by Gupta, U.S. Pat. 5,343,535 ("Gupta").

Claim 14 is independent and, as amended, specifies that the portable power source is used in a hand-portable consumer device. Examples of such devices are telephones, computers, power tools, and consumer products such as electric razors and electric toothbrushes. Dependent claims directed to these devices also have been added; see new claims 44-49. See page 12, end of bridging paragraph, for support.

Gupta relates to battery packs for use with electric cars. The battery pack includes "a computer controlled sampling and data-collection/communication system" (6 in Fig. 1) that, for example, may provide an information dump to a central computer over a phone line when the

battery pack is recharged at a charging station. The information can be used, for example, to generate a bill for the consumer. See col. 10, lines 28-35.

Gupta does not disclose or suggest using the system on other types of products. In fact, Gupta is concerned with known problems associated with battery packs used for electric cars. See the lengthy Background of the Invention section of Gupta.

Claim 14 is not anticipated by Gupta because Gupta does not describe hand-portable consumer devices. Claims 5, 7, 8, 15, and 17-19 depend directly or indirectly from claim 14 and are not anticipated by Gupta for at least the same reason. In addition, claim 14 is not obvious under 35 U.S.C. § 103(a) in view of Gupta because Gupta does not suggest using the system with anything except cars. As discussed above, Gupta is focused narrowly on known problems associated with battery packs for electric cars and does not suggest that other products, in particular portable consumer devices, have the same or analogous problem.

Applicant therefore requests that the 35 U.S.C. § 102(b) rejection be withdrawn.

Claims 2, 3, 6, 9, 10, 16, and 28-31 have been rejected as obvious under 35 U.S.C. § 103(a) over Gupta in view of Thandiwe, U.S. Pat. 6,456,036 ("Thandiwe"). Claim 24 has been rejected under 35 U.S.C. § 103(a) over Gupta in view of Fischl et al., U.S. Pat. 5,293,103. Claims 2, 3, 10, 24, and 28-31 have been cancelled. The remaining claims depend directly or indirectly from claim 14, which has not been rejected over Gupta in combination with Thandiwe and is patentable for the reasons explained above. In any event, Thandiwe does not relate to battery packs for electric cars or the billing issues associated with battery packs for electric cars. Therefore, there is no suggestion to combine Gupta with Thandiwe.

Applicant also notes that Thandiwe potentially qualifies as prior art to the present application (filed December 4, 2000) because of its 35 U.S.C. § 102(e) date of September 24, 2000, but only if the methods covered by the pending claims were not invented by applicant prior to that date. It is not necessary for applicant to investigate at this time if such an earlier invention date can be established because the claims are patentable over Thandiwe in any event. However, applicant reserves the right to investigate this issue further.

Thus, applicant requests that the 35 U.S.C. § 103(a) rejection also be withdrawn.

A check in the amount of \$290.00 for the multiple dependent claim fee is enclosed. Please apply any other charges or credits to deposit account 06-1050.

Applicant : Douglas J. Woodnorth
Serial No. : 09/729,634
Filed : December 4, 2000
Page : 6 of 6

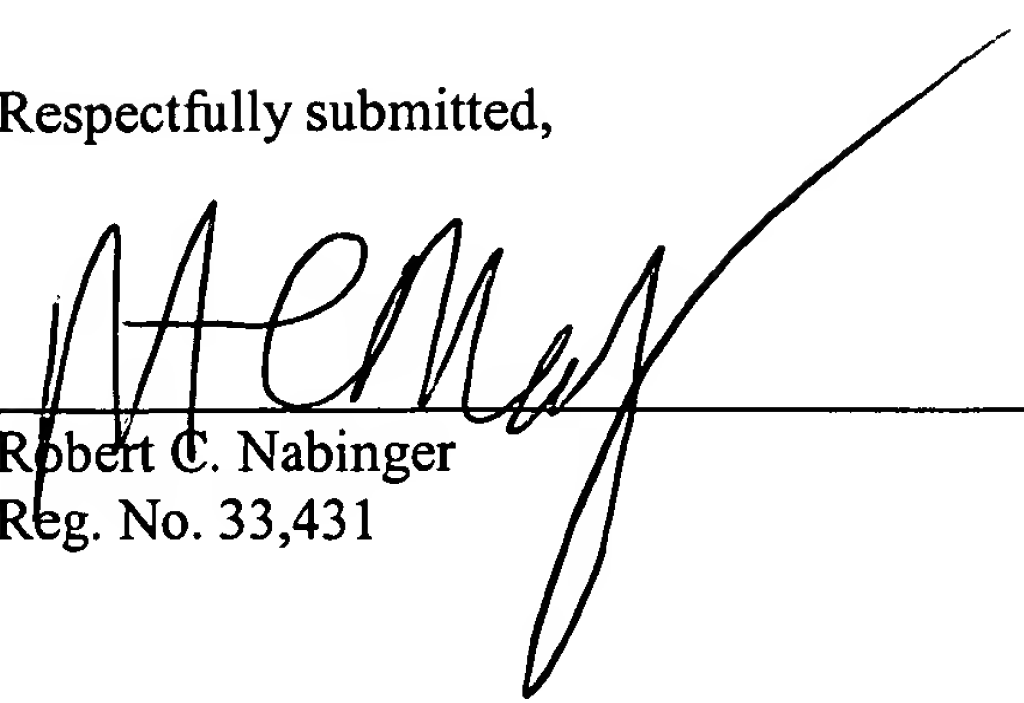
Attorney's Docket No.: 08935-226001 / M-4934

Respectfully submitted,

Date: April 28, 2004

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110-2804
Telephone: (617) 542-5070
Facsimile: (617) 542-8906

20847727.doc



Robert C. Nabinger
Reg. No. 33,431